

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of Confirmation No.: 5690
Ilana (Helena) Nathan Date: December 29, 2008
Serial No.: 10/509,405 Group Art Unit: 1654
Filed: September 24, 2004 Examiner: Ronald T. Niebauer
For: COMPOSITIONS AND METHODS FOR TREATING AND PREVENTING
NECROSIS

VIA EFS - WEB

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO SPECIES ELECTION REQUIREMENT

Sir:

In the Office Action mailed in this case on June 25, 2008, claims 1, 3-4 and 15-17 are subject to a species election requirement.

The Examiner is requiring the applicant to elect a specific species of an “anti-apoptotic agent” as that term is used in certain of the claims.

Applicant, therefore, elects without traverse the species of anti-apoptotic agent known as z-VAD-fluoromethylketone (“fmk”). Claims 1, 3-4 and 15-17 are all believed to be generic and Applicants believe that claims 1, 3-4 and 15-17 all encompass the herewith elected species, fmk.

The elected agent is a species of the genus caspase inhibitors, which genus is specifically taught in applicant’s specification as being useful as an anti-apoptotic agent in the practice of the claimed invention (see the paragraph bridging pp. 10-11 of International Publication No. WO 03/079969). While the elected species is not specifically recited in the specification, applicant respectfully submits that one having an ordinary level of skill in this art at the time the invention was made would readily recognize z-VAD-fmk to be a member of the class of caspase inhibitors. Submitted herewith in support is a declaration of co-inventor, Professor Ilana Nathan, which discusses certain experiments carried out by Prof. Nathan (or performed under her supervision) which support the following conclusions: (1) z-VAD-fluoromethylketone (z-VAD-fmk), in

combination with elastase inhibitors such as elastase inhibitor III, effectively serve to reduce KCN-induced cell necrosis; and (2) that one of ordinary skill at the time of the filing of the present application in 2004 would recognize and understand that z-VAD-fluoromethylketone is a typical member species among the class of effective anti-apoptotic agents known as caspase inhibitors.

Entry of this response into the file of the present application is, therefore respectfully requested.

CONTINGENT EXTENSION REQUEST

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner for Patents is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

THIS CORRESPONDENCE IS BEING
SUBMITTED ELECTRONICALLY
THROUGH THE PATENT AND
TRADEMARK OFFICE EFS FILING
SYSTEM ON December 29, 2008.

Respectfully submitted,



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